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EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/863,877	Applicant(s) AMANO ET AL.	
	Examiner Jean D. Janvier	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

Specification

Status of the claims

Claims 2 and 3 are canceled and claims 1, 4-9 and newly added claim 10 are currently pending in the Instant Application.

General Comments

Through the claimed invention or more particularly throughout the independent claims, the user or customer has never been exposed to the advertisement in the past and the storage device contains no points since the user has not viewed or selected any advertisements thus far. In other words, past interactions or older points accumulation record were not available since the claims never recite such elements. Thus, the display point degree will not decrease when the user views the advertisement since it will be the first time that the user has seen the advertisement.

Furthermore, the amended claims call for decreasing a point degree for displaying the same advertisement on a subsequent encounter after the user has been exposed to the advertisement. However, it is rather unclear here whether or not the subsequent display of the advertisement is to the same user or to other users.

Finally, although the Examiner is not issuing a 112(1) rejection, however, the sections or the portions of the specification, i.e. page 36: 2 to page 37: 21 and fig. 12,

Art Unit: 3622

cited by the Applicant **do not expressly show a point degree that does not decrease to zero for the subsequent display of the advertisement.**

Claim Objections

Claims 4, 6-7, 5, 8, 9 and 10 are objected to because of the following informalities-

Concerning claims 4, 6 and 7, “An advertisement supplying.....” should apparently be - -The advertisement supplying...--.

Concerning claims 5 and 8-10 (including their dependent claims), the use of the auxiliary verb “may” in the preambles renders the claims indefinite.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 are rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is said to be ambiguous or confusing for reciting “The advertisement supplying system as claimed in claim 1 wherein: a minimum value of the point degree to be displayed is equal to zero” since parent claim 1 recites that “the point degree does not decrease to zero”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-10 are rejected under 35 USC 103(a) as being unpatentable over Goldhaber, US Patent 5, 794, 210, in view of Roth, WO 98/34189.

As per claims 1 and 4-10, Goldhaber discloses a system wherein, in one embodiment, an advertiser 62 creates one or more ads 68 that appeal to certain consumers 64, not to others, in accordance with their interest profile 124 (targeted advertisements).

Art Unit: 3622

The advertiser 62 provides or forwards the created and targeted ads 68 to the Attention brokerage server 106, for permanent storage and later retrieval (storage apparatus), acting as a broker or intermediary between the consumers or viewers 64 and advertisers 62, which transmits or routes the one or more created ads 68 to appropriate consumers 64, upon logging into the system or server 106, contingent upon their psychographic profile 124 (identification data), stored on the Attention brokerage server 106, matching the advertiser's 62 interest profile or criteria (displaying a targeted ad on the viewer's terminal 104 upon identifying the user or viewer when the viewer logs into the server or storage apparatus 106 over the network 102). In short, Attention brokerage servers 106 store information and disseminate it to consumers' computers 104 over a network 102 (Internet) and the servers 106 provide the software agent 110 with targeted or tagged ads, directed to the consumers' or users' attention in accordance with their interest profile 124, to be viewed or reviewed by consumers 64. Moreover, in another embodiment, a software agent 110 related to a user's 64 device or computer 104, working on behalf of the user, screens and filters the incoming ads 68, provided to the Attention brokerage server 106 by advertiser or advertisement owner 62, transmitted by the Attention brokerage server 106 to be displayed to the user 64 based on the user's psychographic information 124 stored on the user's computer 104 local database 120. Subsequent to this screening or filtering process, matches achieving a certain threshold of interest (adjustable by the consumer who owns the profile) represented in the form of "agent reports" consisting of short summaries or thumbnails or pointers are displayed on the user's computer 104, wherein, upon activating a thumbnail view indicative of an ad matching, the user's computer 104 or the software agent 110 retrieves the full text and/or

Art Unit: 3622

graphics corresponding to the matched advertisement 68. In other words, the software agent 110 maintains the user's psychographic or interest profile 124 confidential and performs the screening, filtering and matching itself based on a correlation between the ad criteria presented by the Attention brokerage server 106, on behalf of the advertiser 62, and the user's interest profile 124 stored on the user's computer 104. When matches are found, as indicated by the software agent 110, the Attention brokerage server 106, which stores in a database the advertiser's ads, delivers the matching ads to the user's computer 104 or the software agent 110 may itself retrieve the matching ads from the Attention brokerage server 106 database to be displayed on the user's computer 104.

Alternatively, the software agent 110 may retrieve "thumbnail" brief summaries of the matching ads, associated with a plurality of advertisers, and display them along with associated Cybercoin icons on the user's computer 104, wherein upon activating a Cybercoin icon, showing a related dollar figure, displayed next to a "thumbnail" brief summary representing a matching ad, the ad full text and/or graphics is retrieved and displayed to the user and the user is compensated in an amount equal to the value of the displayed Cybercoin (displaying a point degree in combination with an advertisement from an advertisement owner or advertiser).

(Col. 14: 17 to col. 15: 17; col. 15: 48 to col. 16: 5; col. 19: 26-31; col. 19: 36-61; col. 9: 53-61; col. 6: 24-31; col. 7: 8-19; col. 8: 41-48; col. 10: 9-38).

Further, Goldhaber discloses a method of and system for brokering and selling the attention of a customer wherein, among other things, advertisers pay or compensate the customer for the opportunity to have their ads read by the customer or subscriber of the system. By clicking on a Cybercoin button (or banner, ad box or link) or selectable

Art Unit: 3622

object, displayed on the customer's PC 104 and representative of an ad, the customer indicates his intention to read the said ad and once the system verifies, through a quiz process, that the customer has indeed read or interacted with the ad or advertisement, which guarantees that the advertiser's message has received full human attention or interaction, the customer is compensated in the form of credits or digital cash (points) for paying attention to the ad. **Here, the value of the credits or digital cash (displayed points degree) is equal to the amount shown on the Cybercoin. As time goes by, the customer accumulates a certain amount of credits or digital cash (points balance) for reading a plurality of targeted ads from a plurality of advertisers, wherein the credits balance or digital cash balance (points total) is stored in a database or customer's digital cash repository 126 and the customer's digital cash repository or the customer's account storing the customer's credits is debited for the customer's use or ordering of information unit, medical report, service, goods, movies, etc (redemption of credits or digital cash).**

In addition, Goldhaber discloses a system wherein one or more ad titles or thumbnails are displayed on the customer's terminal along with one or more respective selectable objects or Cybercoins showing the associated monetary amount that the customer will earn if he activates a particular selectable object to read the corresponding advertisement (full version of the ad).

(Col. 16: 6-64; fig. 12; col. 7: 48-61; col. 11: 32-38) and (Col. 4: 47-63; Col. 19: 56-67; figs. 10-11).

Furthermore, Goldhaber discloses a system wherein advertisers pay users to view their advertising messages in accordance with the user's profile matching the advertisers'

Art Unit: 3622

criteria or specifications (advertiser's rule to determine a point degree or monetary value of a displayed Cybercoin related to an ad). For example, if a user provides no profile data to an interesting advertiser, then the point degree or the monetary value shown on a displayed Cybercoin, related to an advertisement from an advertiser, is less significant. On the other hand, if the user makes his profile available to the interesting advertiser, who uses the profile information to tailor his ads to the user, then the displayed point degree or monetary value related to the displayed Cybercoin corresponding to the advertisement from the advertiser is more significant (col. 14: 5-10). In another embodiment, the point degree or the monetary value related to a displayed Cybercoin corresponding to an ad from an advertiser is determined based on the highest bid amount offered by an interesting advertiser from a plurality of advertisers for the opportunity to present at least one ad to a targeted user, wherein the bidding process may be silent (passive) or active (advertiser's criteria to determine a point degree...-col. 4: 32-64).

Additionally, Goldhaber discloses a system wherein once a user has successfully activated a displayed Cybercoin and adequately read or interacted with the associated advertisement, then the user's digital cash repository 126 is updated or increased accordingly and **the displayed Cybercoin is deactivated (or its value is now equal or decreased to zero)** to prevent the user from repeatedly clicking on the Cybercoin in the future to read the same advertisement and being compensated for such actions (fig. 12; col. 17: 33-63). It is further recognized that the displayed Cybercoin 62 (selectable object or banner) may be replaced with a coupon icon 63, which performs similar functions (sort or type of point degree or Cybercoin 62 or coupon icon 63 monetary value or amount-col. 18: 13-33).

Art Unit: 3622

In short, Goldhaber teaches a system wherein a Cybercoin (display point degree) is displayed on the user's screen along with a targeted ad (in the form of a thumbnail or otherwise-fig. 11) and the user's account or digital cash repository 126 is increased by an amount equal to the value of the displayed Cybercoin or display point degree. Here, when the user clicks on the ad for the first time, the value of the Cybercoin or display point degree is greater than zero (the display point degree does not decrease to zero at this stage). However, in one specific embodiment, it is described that once the user has seen the ad, at least once, the user will not be compensated in the future for reading the same ad. In other words, the value of the Cybercoin or display point degree associated with the same displayed ad decreases to a zero value subsequent to the user reading the ad at least once (Here, at least, Goldhaber hints on the step of displaying the same ad to the user more than once).

As per claims 1, 4 and 8-10, although Goldhaber hints on the step of displaying the same ad to the user more than once, however, he does not officially or expressly indicate providing less payment or points to the user for selecting the advertisement in subsequent displays.

However, Roth discloses a method and/or system for providing advertisements from a server to viewers (10) who access web sites (14) over the Internet based at least on the viewers or users (10) characteristics or profile, which match a set of criteria or characteristics associated with the advertisements (16A) from the advertisers or distributors. A viewer (human) 10 using a client PC running a client browser 11 visits a

Art Unit: 3622

web site 14 having an HTML reference to a view server 320 for signaling the occurrence of a view-op. In other words, this visit at the registered or participating web site 14 triggers a view-op, that is an opportunity to transfer a targeted advertisement to the visitor or viewer if his profile variables match one or more advertisers' profile attributes and in accordance with the highest bid received from bid input server 18 on behalf of a bid winner or advertiser who bid along with other advertisers for the opportunity to transfer or present one targeted advertisement to the user or viewer who causes the view-op. A web server 310 coupled to the user's client PC sends the view-op signal to the view server 320 of fig. 3, which retrieves among other things the user's profile stored in database 16B (database of viewer information) and passes it to bidding agent 30 (intermediary), which receives a plurality of proposed bids from bid input server 18 (intermediary or agency working on behalf of the advertisers or bidders), for comparing and evaluating the viewer's profile to the plurality of proposed bids specifications and wherein the result of this comparison or evaluation, that is a number of selected proposed bids along with their related bid prices, is forwarded to the bid selection logic 16C coupled to view server 320 for selecting the highest bid. Following the highest bid selection, the view server 320 transmits a signal to web server 310 to retrieve from database 16A or ad table 16A the advertisement associated with the winning bid to be presented to the viewer of the view-op. At the conclusion of the transaction, the database 16B is updated to reflect a successful view-op. Further, a log and billing unit 320A collects data regarding the view-op, wherein the data are used for billing and auditing purposes. **It is herein understood that the proposed bids, including bid prices, bid profile attributes requirements and r associated advertisements, are stored or recorded in the system database or**

Art Unit: 3622

database 18T coupled to the bid input server 18 of fig. 3 prior to the user's or viewer's visit or view-op occurrence. It is further understood that the system is advertised to the advertisers or advertising distributors via conventional means and desired bid information, including bid prices, profile attributes requirements or targeted audience and the associated advertisements, are collected ahead of time from interested advertisers and supplied to bid input server 18 (agency or third party) for storage in database 18T where the bid information or proposed bids from a plurality of responding advertisers is retrieved and delivered, during a view-op event, to bidding agent 30 for comparing and evaluating the bid information to the viewer's profile when a view-op occurs. Moreover, the submitted bids or the responses from the plurality of advertisers contain various profile attributes requirements that must be satisfied by a view-op, wherein these various profile attributes submitted by various advertisers form a number combination of different profile attributes (fig. 3, 5 and 7; page 11: 16 to page 14: 3; page 22: 1 to page 24: 1; page 26: 4 to page 37: 2).

Furthermore, if a viewer profile (variables) does not contain all the attributes specified in a proposed bid submitted by an advertiser, then the proposed bid in response to a view-op will not be considered by the bidding agent 30, which evaluates the proposed bid vis-à-vis the incoming view-op profile. The advertiser has the latitude in choosing the profile attributes that he feels or deems relevant to help the viewer make a buying decision (page 22: 1-9). **Additionally, the bid profile attribute requirements or criteria may be very stringent in a situation where the proposed bid price is high and the advertiser wants to reach only a very selected group of**

Art Unit: 3622

viewers. On the other hand, the criteria may be loose if the bid price is low and the advertiser wants to reach a large number of viewers who meet only a minimum set of criteria or fewer profile attributes than the actual profile attributes specified by the advertiser or bidder. For example, a proposed bid might have a single attribute or criterion such that the view-op is from all users who use "Netscape browser". In this case, the total economic value related to the price of all attributes within the profile is equal to the price of the single criterion specified in the bid. Alternatively, a proposed bid might specify values or contain a plurality of attributes (a, b, c, e, g, h, and i), wherein a, b, c, e, g, h, and i representative of various attribute values may be different for each bidder or advertiser. In other words, if the advertiser's bid or response contains one single requirement or profile attribute, such as that the user is a Netscape User, then the advertiser's proposed bid features a single attribute having a price or economic value that the advertiser wants to pay to display an advertisement to a user who is a "Netscape User". Another advertiser might bid ten cents if the view-op is from a user who had recently visited a particular web page and one cent for the same view-op if the user or viewer had not recently visited the particular web page. Another advertiser may submit a bid that offers, among other things, a specific price if the viewer causing the view-op has previously visited a financial web site. Here, and in general, the number of profile combinations resulting from the advertiser's proposed bid or response is one (1) since there is only one single attribute ("Netscape User", "visiting the particular web page", "financial web site" requirement) (determining a bid price for a response by adding the economic

Art Unit: 3622

values for the individual attributes in a profile combination). In other words, although there may be other attributes in the proposed bid or response, however, only the attribute(s) that the advertiser really cares for has an economic value or price tag associated with it. It is further recognized here that the number of profile combinations and the total price value for each profile combination resulting from the advertiser's bid response or proposed bid as shown above are determined before a view-op occurs (in a preparation for a view-op or visit).

Furthermore, in a particular embodiment, an advertiser may submit multiple form objects at multiple levels. For instance, an advertiser may submit a bid, having a series of attributes, in which the advertiser may specify a level one proposal of five cents if some of the attributes are met by a view-op and a level two proposal of four cents if some other attributes are met. As shown in fig. 5 and indicated above, each proposed bid might include several bid levels. Here, a process is executed for each level of each proposed bid. When a view-op occurs, the Level 0 is "run" first, the Level 1 next, and so on. This means that level 0 requirements (attributes required) are evaluated first by bidding agent 30. If they succeed, then bid is placed as dictated in that level's data. Otherwise Level 1 requirements are checked, and so on and so forth (each proposed bid or advertiser's response is spread to form multiple combinations of attributes or to form multiple bid levels where each bid level has different attributes or criteria, wherein each bid level or attribute combination has an associated economic value or price tag). The proposed bid evaluation process shown in fig. 5 performs tests upon a received proposed bid prior to submitting an actual bid to view server 320.

(Page 26: 6 to page 29: 4; figs. 5 and 6).

Finally (**specifically regarding the present claimed invention**), Roth discloses a system wherein each advertiser provides one or more "proposed bids", which specify how much the advertiser is willing to pay for displaying a particular advertisement in response to a view-op with certain characteristics (or a user's visit). Each proposed bid can specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement to a viewer who has a particular set of characteristics and on a web site and web page that meets a particular set of criteria. Each proposed bid can be dependent upon or require satisfaction of various criteria, which must be met in order for a bid of a particular amount to be submitted. **For example, an advertiser might specify that the first one thousand times that view-ops (users) meeting certain criteria occurs, a bid of five cents will be submitted for displaying a specific advertisement and each time thereafter that a view-op (user) meeting the criteria occurs a bid of one cent will be submitted (page 3: 19 to page 4: 10).**

Furthermore, it is common practice in the art to display an ad to a user more than once (multiple times) until the user takes a favorable action by either clicking on the ad to require additional information or purchasing a product or service featured in the ad, thereby rendering the system more effective (See USP 5,848,396 and col. 2: 36-42).

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to display an ad to a user more than once or multiple times until the user

Art Unit: 3622

takes a favorable action by either clicking on the ad to require additional information or purchasing a product or service featured in the said ad, wherein the user receives a higher amount of digital cash (point degree) equal to the value of the Cybercoin displayed next to the ad on the user's computer screen the first time he selects the ad and wherein the digital cash or point degree, given to the user, decreases thereafter for each additional selection or viewing of the same ad by the user until the user takes the favorable action, thereby rendering the advertising distribution system more effective by encouraging the user to select or view an ad more than once, by compensating the user for each subsequent viewing or selection of the ad previously selected by the user, until the user takes a positive or favorable action by either clicking on the ad to require additional information or purchasing a product or service featured in the ad.

Response to Applicant's Arguments

Applicant's arguments with respect to the claimed invention have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6,529,878 to De Rafael discloses a system and method for compensating users for responding to advertisements in an interactive manner by posing questions for users and dynamically generating further questions in response to users' answers to

Art Unit: 3622

previous questions. A user sets up an account on a remote computer that is then credited each time a user has completed the series of questions and answers relating to an advertisement. In setting up the account, the remote computer obtains demographic information from the user, such as the user's name, age, gender, place of residence and occupation. The remote computer can generate the questions not only in response to answers to previous questions but also in response to the demographic information. The remote computer provides the advertisers with the users' answers or with statistical information computed in response to the answers and the user demographics.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719

07/19/06

JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622

JEAN D. JANVIER
PRIMARY EXAMINER

